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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,169	02/03/2006	Jean-Marie Badoz	MICROM24	1184
7590 10/18/2007 Cohen Gary M Strafford Building Number Three Suite 300 125 Strafford Avenue Wayne, PA 19087-3318			EXAMINER WILSON, JOHN J	
			ART UNIT 3732	PAPER NUMBER
			MAIL DATE 10/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/567,169

Applicant(s)

BADOZ ET AL.

Examiner

John J. Wilson

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/30/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant appears to be arguing that the base, and therefore, snap fastener of the head is located at the open end for the tool and that the claims are so limited. It is held that there is no teaching or disclosure to support that these elements are located as now stated, instead, from the original disclosure, it appears that the snap fastener, and base, are located in the area of the projection at the back of the head. As to claim 15, the original disclosure does not support the language, "allows" one use only. The original disclosure teaches can be one use only.

Claims 8-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the

Art Unit: 3732

invention. From applicant's remarks, it appears the snap fastener and shapes are located at the opening of the head, however, there is no teaching of where. It appears from the new drawing figures that the openings are located in element 1, however, this is not clear. If it is in element 1, how is the instrument press fit in the head. What part of the instrument is pressed? How is the opposite end of the instrument aligned with the projection. What kind of material is the front part of the head, and element 1, made of that allows for deforming while returning to its original shape and at the same time providing sufficient support for the element to rotate in.

Specification

The amendment filed August 20, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: New figures 2 and 3, and the amended specification to refer to these contain new matter not shown in the original disclosure. From the original disclosure, it appears that the snap fastener is located in the area of the projection shown in the original drawings. There was no support for locating these elements on the opposite side of the head as now shown.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-13, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Euvrard (6155827) in view of Butler (5120220). Euvrard shows a canal preparation device, column 1, line 7, support 4, instrument 2, shank 5, rotational drive means 6 and head 7. Euvrard does not show using snap-fastening means. Butler teaches using snap-fastening means 31, 32. It would be obvious to one of ordinary skill in the art to modify Euvrard to include the snap-fastening means of Butler in order to better assemble the parts, and it is noted that Euvrard suggests an alternative type of hand piece, column 1, lines 5-8, that is the same as Butler. To call the region of the head of Butler shown at 56, the base is merely terminology and would be obvious to the skilled artisan. Butler teaches element 32 is made of a material that allows 31 to be snapped in, column 5, lines 17-20, and as such, this teaches one of ordinary skill in the art using a base that is allowed to deform. The specific shape of the snap fastener opening is an obvious matter of choice in the shape of known structures to one of ordinary skill in the art. As to claim 15, the shown material is inherently capable of being used only once. As to claim 16, see pinion 3 of Euvrard.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Euvrard (6155827) in view of Butler (5120220) as applied to claim 8 above, and further in view of Garnier (3578745). The above combination does not state the material of the instrument. Garnier teaches a canal preparation instrument made of steel, column 4, lines 38-40. It would be obvious to one of ordinary skill in the art to modify the above combination to include the use of steel as shown by Garnier in order to make use of known materials for canal preparation instruments to best prepare a canal.

In view of applicant's remarks that appear to interpreting the base in the claims as being limited to the open end of the head, the following rejection is being made.

Claims 8-13, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Euvrard (6155827) in view of Butler (5120220) and Bailey (5730595). Euvrard shows a canal preparation device, column 1, line 7, support 4, instrument 2, shank 5, rotational drive means 6 and head 7. Euvrard does not show using snap-fastening means. Butler teaches using snap-fastening means 31, 32. It would be obvious to one of ordinary skill in the art to modify Euvrard to include the snap-fastening means of Butler in order to better assemble the parts, and it is noted that Euvrard suggests an alternative type of hand piece, column 1, lines 5-8, that is the same as Butler. Butler teaches element 32 is made of a material that allows 31 to be snapped in, column 5, lines 17-20, and as such, this teaches one of ordinary skill in the art using a base that is allowed to deform. The specific shape of the snap fastener opening is an

obvious matter of choice in the shape of known structures to one of ordinary skill in the art. The above combination does not show locating the snap fastener elements at the open side of the head. Bailey shows locating a snap fastening means 41, 45 at the open side of the head, Figs. 4-10. It would be obvious to one of ordinary skill in the art to modify the above combination to include locating the elements as shown by Bailey in order to make use of known locations for art known elements. As to claim 15, the shown material is inherently capable of being used only once. As to claim 16, see pinion 3 of Euvrard.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Euvrard (6155827) in view of Butler (5120220) and Bailey (5730595) as applied to claim 8 above, and further in view of Garnier (3578745). The above combination does not state the material of the instrument. Garnier teaches a canal preparation instrument made of steel, column 4, lines 38-40. It would be obvious to one of ordinary skill in the art to modify the above combination to include the use of steel as shown by Garnier in order to make use of known materials for canal preparation instruments to best prepare a canal.

Drawings

The drawings submitted August 20, 2007 are objected for containing new matter as described above.

Information Disclosure Statement

The IDS filed August 30, 2007 has been considered and an initialed copy is attached.

Response to Arguments

Applicant's arguments filed August 20, 2007 have been fully considered but they are not persuasive. It is held that applicant's disclosure, as originally filed, was not sufficient to enable and support the invention as now disclosed and claimed, see rejections and objection above. Applicant's remarks with respect to the location of the elements are responded to in the rejections and newly applied art above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3732

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez, can be reached at 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**/John J Wilson/
Primary Examiner
Art Unit 3732**

jw
October 13, 2007